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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,883	01/31/2001	Kenneth F. Carpenter JR.	UV-180	7944
1473	7590	03/23/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			BELIVEAU, SCOTT E	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,883

Applicant(s)

CARPENTER ET AL

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2006-03-08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 January 2006 and subsequent response 08 March 2006 has been entered.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e). The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/179,523, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The '523 filing discloses "providing at least

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two cells on a display screen, wherein each of the at least two cells is operable to be associated with a television channel and is operable to display within the cell, video content being broadcast on the television channel”. The filling, however, does not disclose that the particular cells further comprise an “indicator which notifies a user of the availability of interactive content associated with the television channel associated with the cell”.

The disclosure of the prior-filed application, Application No. 60/179,552, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The ‘552 filling discloses the missing element of the ‘523 filling of “displaying an indicator which notifies a user of the availability of interactive content associated with the television channel associated with the cell” and “for a cell in which an indicator I displayed and which is in focus, allowing a user to access the interactive content associated with the television channel associated with the cell”. However, the ‘552 filling does not “providing at least two cells on a display screen, wherein each of the at least two cells is operable to be associated with a television channel and is operable to display within the cell, video content being broadcast on the television channel”. Neither prior-filling contemplates or incorporates disclosure of the other. Accordingly, the application shall be examined on the basis of its filling date or 31 January 2001.

Response to Arguments

3. Applicant's arguments with respect to claims 66-85 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 66-68 and 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III (US Pat No. 5,815,145) in view of Matthews, III et al. (US Pat No. 6,025,837).

In consideration of claim 66, the Matthews, III reference discloses a “method for using an interactive application” or program guide on a “display screen” [18] to access content. As illustrated in Figure 4, the method comprises “providing at least two cells” [104] on a “display screen” [18] wherein “each of the at least two cells is operable to be associated with a television channel and is operable to display, within the cell, video content being broadcast on the television channel” and a “user [is allowed] to navigate a cell highlight to each of the at least two cells, wherein only the cell that is surrounded by the cell highlight is in focus” (Figure 5; Col 4, Line 44 – Col 5, Line 46). The reference, however, is silent with respect to

“notifying a user of the availability of interactive content” that the user is subsequently able to access.

In an analogous art pertaining to interactive television applications, Figures 5 and 6 of the Matthews, III et al. reference discloses “for each of the at least one of the cells that is associated with a television channel, displaying an indicator which notifies a user of the availability of interactive content associated with the television channel associated with the cell” and “for a cell which an indicator is displayed and which is in focus, allowing a user to access the interactive content associated with the television channel associated with the cell” (Col 9, Line 1 – Col 10, Line 37; Col 10, Line 56 – Col 11, Line 21). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the Matthews, III interface so as to further “display an indicator which notifies a user of the availability of interactive content associated with the television channel associated with the cells” and to further “allow a user to access the interactive content associated with the television channel associated with the cell” for the purpose of advantageously provide a means by which to integrate supplemental content within the program guide for easy access (Matthews, III et al.: Col 4, Lines 17-24 and 59-65).

In consideration of claim 76, the Matthews, III reference discloses a “system for accessing content through an interactive application” or program guide. The system comprises a “display screen” [18], a “communication link” [50] “configured to access content” and a “processor” [58] (Figure 2; Col 7, Line 7 – Col 8, Line 14). The “processor” is configured to “instruct the display screen to display at least two cells” [104] wherein “each of the cells is operable to be associated with a television channel and is operable to display,

within the cell, video content being broadcast on the television channel” and a “allow a user to navigate a cell highlight to each of the at least two cells, wherein only the cell that is surrounded by the cell highlight is in focus” (Figure 5; Col 4, Line 44 – Col 5, Line 46). The reference, however, is silent with respect to “notifying a user of the availability of interactive content” that the user is subsequently able to access.

In an analogous art pertaining to interactive television applications, Figures 5 and 6 of the Matthews, III et al. reference discloses “for each of the at least one of the cells that is associated with a television channel, instructing the display screen to display an indicator which notifies a user of the availability of interactive content associated with the television channel associated with the cell” and “for a cell which an indicator is displayed and which is in focus, allowing a user to access the interactive content associated with the television channel associated with the cell” (Col 9, Line 1 – Col 10, Line 37; Col 10, Line 56 – Col 11, Line 21). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the Matthews, III interface so as to further “display an indicator which notifies a user of the availability of interactive content associated with the television channel associated with the cells” and to further “allow a user to access the interactive content associated with the television channel associated with the cell” for the purpose of advantageously provide a means by which to integrate supplemental content within the program guide for easy access (Matthews, III et al.: Col 4, Lines 17-24 and 59-65).

Claims 67 and 77 are rejected wherein the “indicator is displayed in at least one of: the cell having an associated television channel for which interactive content is available, and an area in close proximity to that cell” (Matthews, III et al.: Figure 5).

Claims 68 and 78 are rejected wherein “for each cell that is associated with a television channel and which is not in focus, displaying in the cell a graphical brandmark of the television channel associated with the cell; and if the cell in focus is associated with a television channel, displaying in the cell video content being broadcast on the television channel” (Matthews, III: Col 4, Lines 56-61; Col 5, Lines 23-36).

7. Claims 69-71 and 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III (US Pat No. 5,815,145), in view of Matthews, III et al. (US Pat No. 6,025,837), and in further view of Lawler et al. (US Pat No. 5,585,838).

In consideration of claims 69 and 79, the combined references are silent with respect to further “displaying an option indicator” as claimed. In an analogous art pertaining to interactive television applications, the Lawler et al. reference discloses “displaying an option indicator which notifies a user of at least one option corresponding to the television channel associated with the cell; and for a cell which is in focus, allowing a user to select one of the at the least one option” (Col 13, Line 53 – Col 14, Line 48). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the combined references so as to “display an option indicator” for the common knowledge advantage of providing a simplified means by which the user can identify desired programs and services and to perform actions related to those programs (Lawler et al.: Col 1, Lines 26-33).

Claims 70 and 80 are rejected wherein the “television channel is a video on demand channel, and wherein the at least one option includes at least one of . . . placing an order for a program from the video on demand channel” (Matthews, III: Col 9, Lines 26-49; Lawler et al.: Col 14, Lines 16-23; Col 16, Lines 35 – Col 17, Line 5).

Claims 71 and 81 are rejected wherein the “at least one option includes at least one of: recording a current program on the television channel, [and] setting a reminder for a future program on the television channel” (Lawler et al.: Col 13, Line 53 – Col 14, Line 48).

8. Claims 72-75 and 82-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III (US Pat No. 5,815,145), in view of Matthews, III et al. (US Pat No. 6,025,837), and in further view of Goldschmidt Iki et al. (US Pat No. 6,295,646).

In consideration of claims 72 and 82, the combined references are unclear with respect to whether or not “at least one of the cells is operable to display Web content within the cell”. In an analogous art pertaining to interactive television applications, the Goldschmidt Iki et al. reference discloses a user interface wherein “at “at least one of the cells is operable to display Web content within the cell” in addition to cells displaying television content (Figure 6; Col 7, Lines 28-51). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the combined references such that “at least one of the cells is operable to display Web content within the cell” for the purpose of advantageously providing a user interface/programming guide which supports entertainment system data from a variety of sources (Goldschmidt Iki et al.: Col 1, Lines 15-36).

Claims 73 and 83 are rejected wherein at least one of the cells is associated with a television channel and at least one of the cells is associated with a non-television entity”. (Goldschmidt Iki et al.: Col 7, Lines 40-51; Col 8, Line 66 – Col 9, Line 42).

Claims 74 and 84 are rejected wherein the method further comprise “receiving a signal indicating selection of the cell in focus; and if the cell in focus is associated with a television channel, displaying, in full screen on the display screen, video content being broadcast on the television channel” (Goldschmidt Iki et al.: Col 9, Lines 29-34).

Claims 75 and 85 are rejected wherein the system/method further “allows a user to disassociate a television channel from a cell; and allows a user to associate a television channel with a cell” in accordance with the user establishment of preferred entertainment sources (Goldschmidt Iki et al.: Col 7, Lines 40-46). Alternatively, the system/method “allows a user to disassociate a television channel from a cell; and allows a user to associate a television channel from a cell” in conjunction with the user scrolling through the listing of entries within the interface such that the first displayed cell would be associated a different channel if the user scrolled the listings as illustrated in Figure 6 of Matthews, III.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

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- The Lawler et al. (US Pat No. 5,805,763) reference provides evidence as to the desirability to provide the user with program related options in association a program selected through a programming guide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614



SEB
March 20, 2006